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Kenneth E. Flick

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02/08/2010

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EXAMINER

BROOKS, MATTHEW L

ART UNIT

PAPER NUMBER

3629

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

creganoa@addmg.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/085,403	<b>Applicant(s)</b> FLICK, KENNETH E.	
	<b>Examiner</b> MATTHEW L. BROOKS	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the RCE filing on 18 December 2009.

### ***Status of Claims***

2. Original claims 1-32 are currently pending.
3. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/2009 has been entered.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3629

5. **Claims 1-32** are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No.: 6,526,335 (Treyz).

6. With respect to **Claim 1**: Treyz discloses:

A method of providing a customer-selected handheld remote control feature package in a vehicle, the method comprising:

(a) installing a universal remote control device in the vehicle (Fig 7), the universal remote control device comprising a controller and a wireless receiver cooperating therewith for permitting wireless enabling the customer-selected handheld remote control feature package from among a plurality of possible handheld remote control feature packages (Fig 17 and Treyz throughout and at C1, 58-65 teaches software install on the automobile personal computer, software in and of itself enables features, Treyz also teaches the automobile personal computer controls everything from remote handheld key chain (C23, 1-23) to GPS (C1, 35-45) and in addition teaches wireless enabling at C19, 3-12);

(b) negotiating sale or lease of the vehicle with the customer and comprising

(i) offering the plurality of possible remote control feature packages the customer (C2, 52-65 “price negotiate” Fig 12 and Fig 14), and

(ii) accepting an order for the customer-selected handheld remote control feature package from the customer (C2, 52-65 “commitment made” and Fig 12 and Fig 14); and

(c) wirelessly enabling the customer-selected handheld remote control feature package for the universal remote control device (C19, 3-12 and Fig 12, 294 and Fig 14

Art Unit: 3629

and Treyz teaches the automobile personal computer controls everything from remote key chain (C23, 1-23) to GPS (C1, 35-45) and in addition teaches wireless enabling at (C19, 3-12 and throughout entire specification). GPS is defined in the specification as one of the options of the "remote control feature package" and Treyz shows user in possession of vehicle with computer in it plus downloading software wirelessly which enables new features [Fig 12 and 14 and C2, 52-65 and C 57, 7-20]).

7. With respect to **Claim 16**: Treyz discloses:

A method of providing a customer-selected remote control feature package in a vehicle, the method comprising:

All of limitations as discussed in claim 1 above plus

(e) wherein providing, installing, negotiating and wirelessly enabling are performed by a plurality of different entities and further comprising sharing revenue among the different entities based on the negotiated customer-selected handheld remote control feature package (This is what a TPCD does; Treyz shows "TPCD"/processing center [C23, 1-23 and C57, 1-60 and C58, 5-10] and The fact that Treyz teaches a computer/box/URCD and that at any/some point a purchaser of the device is negotiating for svcs/RMCF (C2, 50-60) and then having the requested services wirelessly enabled, wherein the services taught by Treyz are GPS/handheld key remote etc).

8. With respect to **Claim 2 and 17**: Treyz discloses

delivering the vehicle to the customer after negotiating and prior to wirelessly enabling (Treyz shows user in possession of vehicle with computer in it plus

Art Unit: 3629

downloading software wirelessly which enables new features [Fig 12 and 14 and C2, 52-65 and C 57, 7-20]).

9. With respect to **Claim 3 and 18**: Treyz discloses

installing is performed prior to negotiating (Treyz shows negotiation before and after installing (C2, 52-65 and C 57, 7-20)).

10. With respect to **Claim 4 and 19**: Treyz discloses

wherein installing is performed after negotiating (Treyz shows negotiation before and after installing (C2, 52-65 and C 57, 7-20)).

11. With respect to **Claim 5**: Treyz discloses

wherein the plurality of possible handheld remote control feature packages have respective different offering prices; and wherein the customer-selected handheld remote control feature package has a negotiated price associated therewith (Treyz teaches wireless enabling of remote control feature packages, certainly/inherently they must have different offer prices depending upon package type/ what is ordered [C2, 52-65 and C 57, 7-20]. AND Treyz teaches negotiating prices for services [C2, 52-65 and C 57, 7-20]).

12. With respect to **Claim 6**: Treyz discloses

negotiating and wirelessly enabling are performed by respective different entities; and further comprising sharing revenue between the different entities and based on the negotiated price for the customer-selected handheld remote control feature package (This is what a TPCH does; Treyz shows "TPCH"/processing center [C23, 1-23 and C57, 1-60 and C58, 5-10]).

Art Unit: 3629

13. With respect to **Claim 7**: Treyz discloses

providing the universal remote control device; wherein the installing, negotiating, and wirelessly enabling are provided by respective different entities; and further comprising sharing revenue between the different entities and based on the negotiating price for the customer-selected handheld remote control feature package (This is what a TPCB does; Treyz shows “TPCB”/processing center [C23, 1-23 and C57, 1-60 and C58, 5-10]).

14. With respect to **Claim 8 and 20**: Treyz discloses

wherein the providing and wirelessly enabling are provided by a same entity (C22, 45-57 “single service provider”).

15. With respect to **Claim 9 and 21**: Treyz discloses

wherein negotiating is performed by a vehicle dealer; and wherein installing is performed after vehicle delivery to the vehicle dealer (Treyz shows multiple ways of installing a personal computer/”universal remote control device” in car [C13, 12-37] including after delivery to user/manufacture/vehicle dealer/”third party installer” [C13, 12-37 and C16, 35-47 and C17, 14-27 and C18, 40-65 user/manufacture/vehicle dealer/”third party installer”]).

16. With respect to **Claim 10 and 22**: discloses

wherein negotiating is performed by a vehicle dealer; and wherein installing is performed prior to vehicle delivery to the vehicle dealer (Treyz shows multiple ways of installing a personal computer/”universal remote control device” in car [C13, 12-37] including after delivery to user/manufacture/vehicle dealer/”third party installer” [C13,

Art Unit: 3629

12-37 and C16, 35-47 and C17, 14-27 and C18, 40-65 user/manufacture/vehicle dealer/“third party installer”]).

17. With respect to **Claim 11 and 23**: Treyz discloses

installing comprises installing the universal remote control device perform at least one of handheld security, handheld remote keyless entry and handheld remote engine starting features associated with respective customer-selected handheld remote control feature packages (C16, 35-47 and C2, 1-5 and Fig 17, 356).

18. With respect to **Claim 12 and 24**: Treyz discloses

security comprises vehicle position tracking (C1, 35-45 and C2, 24-30).

19. With respect to **Claim 13**: Treyz discloses

the universal remote control device comprises a GPS receiver for performing the vehicle position tracking (C1, 37-45).

20. With respect to **Claim 14 and 25**: Treyz discloses

the wireless receiver comprises a cellular radio receiver; and wherein the wirelessly enabling comprises using a cellular radio transmitter (Fig 11 and C18, 40-68 and C17, 14-26 and Fig 12, 294).

21. With respect to **Claim 15 and 26**: Treyz discloses

the vehicle comprises a data communication bus extending there through; and wherein installing comprises connecting the universal remote control device to the vehicle data communication bus (C15, 40-47 “communications bus”).

22. With respect to **Claim 27**: Treyz discloses



A system for providing a customer-selected remote control feature package in a vehicle, the system comprising:

(a) a universal remote control device for installation in the vehicle, said universal remote control device comprising a controller and a wireless receiver cooperating therewith for permitting wireless enabling of the customer-selected handheld remote control feature package from among a plurality of possible handheld remote control feature packages (Fig 17 and C18, 40-69); and

(b) customer-selected handheld remote control feature package processing station for

(i) receiving an order for the customer-selected remote handheld control feature package (Fig 16, 352 and “TPCH” discussed above),

(ii) wirelessly enabling the customer- selected remote control package for the universal remote control device based upon the order (C18, 40-69), and

(iii) sharing revenue among different entities based upon the customer-selected handheld remote control feature package (C18, 40-69).

23. With respect to **Claim 28**: Treyz discloses

customer-selected handheld remote control feature package processing station comprises an accounting database for sharing the revenue (C22, 54-56).

24. With respect to **Claim 29**: Treyz discloses

universal remote control device performs at least one of handheld remote security, handheld remote keyless entry and remote engine starting features associated with respective customer- selected remote control feature packages (Fig 17).

Art Unit: 3629

25. With respect to **Claim 30**: Treyz discloses

universal remote control device comprises a GPS receiver for performing vehicle position tracking (C1, 36-47).

26. With respect to **Claim 31**: Treyz discloses

wireless receiver comprises a cellular radio receiver; and wherein said processing station wirelessly enables the customer-selected handheld remote control feature package using a cellular radio transmitter (C12, 21-44).

27. With respect to **Claim 32**: Treyz discloses

the vehicle comprises a data communication bus extending there through; and wherein said universal remote control device interfaces to the vehicle data communication bus (Fig 7 and C16, 40-47).

### ***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3629

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

30. Claims **Claims 1-32** are rejected, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of MPEP obvious rationale to make portable.

Which addresses head on the new "handheld" limitations. (See MPEP 2144.04 Legal Precedent as Source of Supporting Rationale)

#### **IV, A. Changes in Size/Proportion**

*In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

#### **V. MAKING PORTABLE, INTEGRAL, SEPARABLE, ADJUSTABLE, OR CONTINUOUS**

##### **A. Making Portable**

*In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

***Response to Remarks***

31. Applicant's remarks filed 12/18/2009 have been fully considered but they are not persuasive. The new "handheld" limitation is not what the Board was suggesting was needed for patentability, as Applicant claims on middle of p. 12 of 14 of Remarks. This is because the enabling of wireless handheld remote control features is taught by Treyz throughout. Treyz enables handheld wireless engine start and other handheld features. See rejection above. Also in general the sprinkling of handheld throughout the claims actually only blurs the matter. This is because it is not really further limiting, especially in regard to the system claims. Also because these features of the remote control feature package are not really hold-able, saying "handheld" makes little sense.

SO In reply to: first and only argument/assertion presented that Treyz does not have "the ability to wirelessly enable handheld remote control features". This is merely not true. Treyz does wirelessly enable features. Treyz teaches the automobile personal computer controls everything from remote key chain (C23, 1-23) to GPS (C1, 35-45) and in addition teaches wireless enabling at C19, 3-12). GPS is defined in the specification as one of the options of the "handheld remote control feature package" Applicant offers.

Further on the same argument, Applicant already admitted on previous Remarks, that Treyz "discloses the ability to remotely subscribe to *digital satellite radio services*, (Col. 22, lines 20-34)" AND the ability to remote order. This admission in and of itself is enough to defeat Applicant's following argument, given that digital satellite radio

Art Unit: 3629

services included remote control feature packages (see OnStar 1 and 2, OnStar offered tracking/GPS and remote door unlock).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. BROOKS whose telephone number is (571)272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John G. Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew L. Brooks/  
Patent Examiner, GAU 3629  
1/28/2010